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EXAMINER

PATEL, GAUTAM

ART UNIT	PAPER NUMBER
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2627

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/670,196

Applicant(s)

PARK ET AL.

Examiner

Gautam R. Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 9-16, 19-25 and 27-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 17, 18 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/15/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-52 are pending for the examination.

Election/Restriction

2. Claims 9-16, 19-25 and 27-52 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to non-elected embodiments other than fig. 7. Election was made with traverse of claims 1-18 and 26.

Applicant's election with traverse of group A and species of fig. 7 in Paper dated 8/7/06 is acknowledged. The traversal is on the ground(s) that "Inventions C and A are not, as alleged, related to as process and apparatus for its practice. ... Similarly invention C and B Invention D and B are not related as ..".

"Additionally, with respect to election of species requirement, the Office Action fails to demonstrate that Figs. 7, 8 and 9 are claimed in a mutually exclusive manner—see MPEP § 806.04(f). In this regard, claim 1's features are found in all of dependent claim 2-18, and claim 19's features are found in all the dependent claims 20-25... In other words, because the process claims are not mutually exclusive, they all must be examined together."

- a. FIRST: To expedite the matter the requirement for Groups A to D hereby is withdrawn, thus making all arguments regarding groups A to D moot.

SECOND: As to arguments that "Office Action fails to demonstrate Figs. 7, 8 and 9 are claimed in a mutually exclusive manner". It should be pointed out that the Applicants themselves have declared that these figures are different embodiments [see page 7, specification].

More importantly MPEP § 806.04(e) clearly states that species are always the specifically different embodiments. And the Examiner does not need to show separate classification or field of search for election of the species requirement. See 803.00 and 808.01(a); M.P.E.P.

THIRD: The specification contains no disclosure of any commonality of operation, function or effect. As a matter of fact different figures are given and it is clearly stated that these are different embodiments.

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- b. As to the argument regarding that claims 1's features are found in claims 2-18. It should be pointed out that the Applicants are stating the obvious, dependent claims always have features of the generic claims.
- c. As to claims 89-94, the Applicants are correct a typographical error was made.
- d. It is also assumed that a typographical error was made by the Applicants on page 18 paragraph 6; since no "Fig3 9A" exist. Clarification is requested.

NOTE: If dependent claims have features that are NOT in the elected figure these claims MUST be removed from the election. Since claims 9-16 does Not have features of fig. 7 they are remove from the election.

Thus elected figure 7 is related only to claims 1-8, 17-18 and 26. These claims will be considered elected.

Action on the above claims 1-8, 17-18 and 26 follows.

The requirement is still deemed proper and is therefore made **FINAL**.

Priority

- 2. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119(a)-(d), which papers have been placed of record in the file.

NOTES & REMARKS

- 3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which Applicant may become aware in the specification.

Drawings/Objection

- 4. The drawings are objected for following reasons:

The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the steps "recording, in the TDMA, management information produced while the recording medium is in use; and transferring and

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recording the latest management information of the TDMA in the DMA at a DMA fill-in stage of the recording medium” must be shown or the features cancelled from the claims.

No new matter should be entered.

Applicant is required to submit a proposed drawing correction in response to this Office Action. Any proposal by the applicant for amendment of the drawings to cure defects must consist of following:

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, and may be *accompanied by a marked-up copy of one or more of the figures being amended, with annotations*. Any replacement drawing sheet *must be identified in the top margin as “Replacement Sheet”* and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. *Any marked-up (annotated) copy showing changes must be labeled “Annotated Marked-up Drawings” and accompany the replacement sheet in the amendment (e.g., as an appendix).*

a proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. Correction may not be held in abeyance.

Correction are required.

Objection to Specification

5. The disclosure is objected for following reasons.

Specification needs to be updated with respect to information on the related applications.

Cross-References to Related Applications: See 37 C.F.R. § 1.78 and section 201.11 of the M.P.E.P.

Claim Rejections - 35 U.S.C. § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 17-18 and 26 are rejected under 35 U.S.C. § 102(e) as being anticipated by Kim et al., US. patent 6,564,345 (hereafter Kim).

As to claim 1, Kim discloses the invention as claimed [see Figs. 1-10, especially 1, 6 and 10] including recording, in the TDMA and transferring and recording the latest management information, comprising the steps of:

recording, in the TDMA, management information produced while the recording medium is in use; and

transferring and recording the latest management information of the TDMA in the DMA at a DMA fill-in stage of the recording medium [col. 6, lines 18-45; col. 7, line 52 to col. 8, line 15; col. 10, lines 19-47 to col. 11, lines 28 to col. 12, line 59].

7. The aforementioned claim 2, recites the following steps, inter alia, disclosed in Kim:

the DMA fill-in stage of the recording medium is when the recording medium is to be finalized [col. 6, lines 18-45; col. 7, line 52 to col. 8, line 15; col. 10, lines 19-47 to col. 11, lines 28 to col. 12, line 59].

8. The aforementioned claim 3, recites the following steps, inter alia, disclosed in Kim:

the recording medium is to be finalized when no more recording in a user data area of the recording medium is allowed [col. 6, lines 18-45; col. 7, line 52 to col. 8, line 15; col. 10, lines 19-47 to col. 11, lines 28 to col. 12, line 59].

NOTE: Here the Applicants are merely claiming how data is recorded and finished according to conventional or normal manner.

9. The aforementioned claim 4, recites the following steps, inter alia, disclosed in Kim:

the transferring step, the latest management information includes latest temporary defect list information and latest temporary disc definition structure information associated with the recording medium [col. 6, lines 18-45; col. 7, line 52 to col. 8, line 15; col. 10, lines 19-47 to col. 11, lines 28 to col. 12, line 59].

10. The aforementioned claim 5, recites the following steps, inter alia, disclosed in Kim:

the recording medium is to be finalized when the TDMA is full and no more management information can be recorded in the TDMA [col. 6, lines 18-45; col. 7, line 52 to col. 8, line 15; col. 10, lines 19-47 to col. 11, lines 28 to col. 12, line 59].

11. The aforementioned claim 6, recites the following steps, inter alia, disclosed in Kim:
the transferring step, the latest management information includes latest temporary defect list information and latest temporary disc definition structure information associated with the recording medium [col. 6, lines 18-45; col. 7, line 52 to col. 8, line 15; col. 10, lines 19-47 to col. 11, lines 28 to col. 12, line 59].

12. The aforementioned claim 7, recites the following steps, inter alia, disclosed in Kim:
the recording medium is to be finalized in response to a user's request [col. 6, lines 18-45; col. 7, line 52 to col. 8, line 15; col. 10, lines 19-47 to col. 11, lines 28 to col. 12, line 59].

13. The aforementioned claim 8, recites the following steps, inter alia, disclosed in Kim:
the transferring step, the latest management information includes latest temporary defect list information and latest temporary disc definition structure information associated with the recording medium [col. 6, lines 18-45; col. 7, line 52 to col. 8, line 15; col. 10, lines 19-47 to col. 11, lines 28 to col. 12, line 59].

14. The aforementioned claim 18, recites the following steps, inter alia, disclosed in Kim:
the transferring step, the latest management information includes a status flag indicating a type of the DMA fill-in stage [col. 6, lines 18-45; col. 7, line 52 to col. 8, line 15; col. 10, lines 19-47 to col. 11, lines 28 to col. 12, line 59].

15. As to claim 26, it is drawn to a system corresponding to the method of claim 1, and is therefore rejected for similar reasons set forth in the rejection of claim 1, above.

Claim Rejections - 35 U.S.C. § 103

16. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kim as applied to claim 1 above.

As to claim 17 Kim discloses all of the above elements including recording, in the TDMA, management information produced while the recording medium is in use and also transferring and recording the latest management information of the TDMA in the DMA at a DMA fill-in stage of the recording medium. Kim does not specifically disclose that the recording medium is a writable-once Blue-ray disc or (BD-WO) to the extent claimed. The limitations in claim 17 do not define a patentable distinct invention over that in Kim since both the invention as a whole and Kim are directed to recording in a TDMA and transferring latest management information of TDMA in DMA. The type of recording medium used for this presents no new or unexpected results, so long as the recording on TDMA takes place latest information is transferred in a successful way. If one has less storage requirement one uses CD-R or CD ROM if one has more storage requirement one may use DVD-ROM [see col. 1, lines 21-30]. Therefore, to have Blue-Ray disc for storage would have been routine experimentation and system requirement & optimization in the absence of criticality.

Other prior art cited

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Ko et al. (US. Patent Application 2004/0105363 A1) "Disc with temporary disc definition structure".
- b) Sako (US. patent 6697306).

Contact information

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18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam R. Patel whose telephone number is 571-272-7625. The examiner can normally be reached on Monday through Thursday from 7:30 to 6.

The appropriate fax number for the organization (Group 2600) where this application or proceeding is assigned is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Dwayne Bost, who can be reached on (571) 272-7023.

Any inquiry of a general nature or relating to the status of this application should be directed to the Electronic Business Center whose telephone number is 866-217-9197 or the USPTO contact Center telephone number is (800) PTO-9199.



Gautam R. Patel
Primary Examiner
Group Art Unit 2627

September 8, 2006